

Attorney Docket No.: 051252-5065
Application No. 09/559,749
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:)

William J. IMOEHL)

Application No.: 09/559,749)

Filed: 30 June 2000)

For: METHOD OF MANUFACTURING)
A FUEL INJECTOR SEAT)

Group Art Unit: 3726

Examiner: Compton, E.

Mail Stop: AF

Commissioner for Patents
U.S. Patent and Trademark Office
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Arlington, VA 22202

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TECHNOLOGY CENTER R3700

Sir:

REQUEST FOR RECONSIDERATION

UNDER 37 C.F.R. § 1.116

In reply to the Final Office Action issued 01 April 2003, the period for reply extending through 01 July 2003, reconsideration of the application in view of the following remarks is requested.

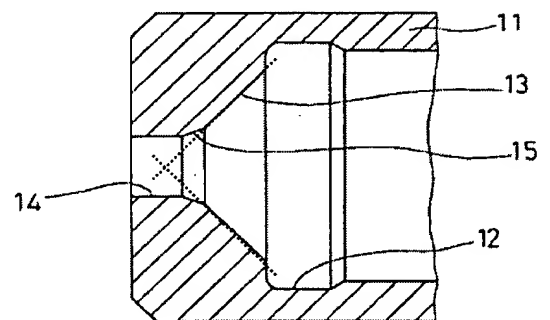
The Final Office Action issued 01 April 2003 has been reviewed and the comments of the U.S. Patent and Trademark Office have been considered. Claims 2-4 and 6-10 are pending. Accordingly, Applicant requests reconsideration of these pending claims.

Claims 2-4 and 6-10 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over JP 60-019957 to Yuji in view of Admitted Prior Art ("APA") of page 1, lines 25-27 of the application and U.S. Patent No. 3,430,388 to Gabrieli. Applicant respectfully traverses the rejection as Yuji, APA and Gabrieli fails to teach or suggest the claimed invention as a whole.

The Office Action confirms that Yuji does not teach or suggest the claimed invention as a whole. The Office Action relies upon the secondary teachings in combination with Yuji in an attempt to provide for the claimed invention as a whole. In particular, the secondary teachings describe and show a conical tool, which may have its axis concentric with the axis of the fuel injector to form a seat surface. That is, the Office Action relies upon the secondary teachings to provide a proposed conical tool for Yuji such that the axis of the proposed conical tool is “concentric with the axis of the fuel injector” in an attempt to provide for the claimed invention as a whole. However, this feature is not recited in any of the claims. Thus, the proposed combination of Yuji, APA and Gabrieli is inappropriate because the proposed combination is directed to a feature not recited in claim 7.

Instead, claim 7 recites a method of forming a fuel injector seat that includes, *inter alia*, forming a sealing portion by “[g]rinding with a tool that has a conical end with a vertex of the conical end disposed in the transition portion ...” This feature is not taught or suggested in the proposed combination of Yuji and the secondary teachings. Yuji shows in Figure 2 (reproduced below) of a conical surface 13 with coupling surface 15. The secondary teachings provide for a conical tool with an apex. At most, the proposed combination could provide for a conical tool

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with the apex disposed outside of the coupling surface 15 and would not teach or suggest all of the claimed features. That is, the proposed conical tool (depicted as dashed lines superimposed over Figure 2 of Yuji) has its grinding surface contacting the conical surface 13 with its apex located outside—instead of inside—of the coupling surface 15.

Applicant respectfully submits that even if Yuji, APA and Gabrielli can be combined, the relied-upon references fail to teach or suggest all of the claimed features as recited in claim 7. Therefore, a *prima facie* case of obviousness has not been established as set forth in MPEP § 2143 (p. 2100-125, 8th Ed., February 2003 Revision). Accordingly, claim 7 is patentable for at least this reason.

Further, Applicant respectfully submits that Yuji and the secondary teachings fail to indicate some objective evidence of a motivation or suggestion that would induce one of ordinary skill in the art to provide for a vertex of a tool to be disposed within the region of the coupling surface 15 of Yuji. Absent the benefits of Applicant's disclosure, there is no motivation or suggestion in Yuji, APA or Gabrieli, singularly or in combination thereof to provide for this feature. Thus, claim 7 is patentable over Yuji in view of APA and Gabrieli, because the relied-upon prior art fails to teach or suggest the claimed invention as a whole.

Claims 2-4, 6, 9, and 10 depend ultimately from claim 7, and are also allowable at least because claim 7 is allowable, as well as for reciting additional features.

CONCLUSION

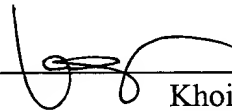
In view of the foregoing remarks, Applicant respectfully requests the reconsideration of this application and allowance of the pending claims 2-4 and 6-10. Applicant respectfully invites the Examiner to contact the undersigned at (202) 739-5203 if there are any outstanding issues that can be resolved via a telephone conference.

EXCEPT for issue fees payable under 37 C.F.R. §1.18, the Commissioner is hereby authorized by this paper to charge any additional fees during the entire pendency of this application including fees due under 37 C.F.R. §§1.16 and 1.17 which may be required, including any required extension of time fees, or credit any overpayment to Deposit Account No. 50-0310. This paragraph is intended to be a **CONSTRUCTIVE PETITION FOR EXTENSION OF TIME** in accordance with 37 C.F.R. §1.136(a)(3).

Respectfully submitted,
MORGAN, LEWIS & BOCKIUS LLP

Date: 01 July 2003

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